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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,722	04/28/2000	RONALD G PARKINEN	K35A0604	5247

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,722

Applicant(s)

PARKINEN ET AL.

Examiner

Thai Tran

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-4</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 5-6, 8-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832).

Regarding claim 1, Sato et al discloses a video recording system to record an external video data for a video program segment selected using an electronic program guide (Fig. 2), the video recording system comprising:

a user interface (the remote controller disclosed in col. 4, lines 46-48 and in col. 5, lines 48-50) that receives user input;

Art Unit: 2615

a video input interface (tuner 37 of Fig. 2, col. 3, lines 59-65) that receives the external video data for the selected video program segment;

an isochronous interface (IEEE1394 disclosed in col. 6, lines 57-60 and video disk disclosed in col. 7, lines 19-26) connectable to an external rotating storage drive; and

a video data management system that:

uses the electronic program guide to select the video program segment in response to the user input (selecting a program disclosed in col. 4, lines 7-19 and in col. 5, lines 34-61);

recognizes connection of the external rotating storage drive to the video recording system and subsequently identifies the external rotating storage drive as available for video data storage (detecting the connection with the VTR 22 disclosed in col. 5, lines 39-47 and col. 7, lines 19-26);

uses the external video data stream for the video program segment to provide video data (selecting television program disclosed in col. 4, lines 7-19 and in col. 5, lines 34-61); and

routes at least a portion of the video data to the external rotating storage drive via the isochronous interface in order to record the external video data for the video program segment (recording video data disclosed in col. 5, lines 31-61). However, Sato et al's Fig. 2 does not specifically disclose that the video data is video data stream (digital video signal).

Sato et al also teaches that video signal can be digital transmitted such as satellite digital broadcasting system (col. 1, lines 13-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known satellite digital broadcasting system disclosed in col. 1, lines 13-21) into Fig. 2 of Sato et al in order to increase the flexibility of the system by permitting the digital video signal to be recorded.

Regarding claim 5, Sato et al's Fig. 2 does not specifically disclose a personal video recorder that receives the external video data stream.

Sato et al teaches in col. 6, lines 61-65 that "In addition, in the configuration shown in FIG.2, one unit of TV is connected to one unit of VTR. It should be noted, however, that three or more AV apparatuses can be connected to each other in a configuration like the one shown in Fig. 1".

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate additional AV apparatus such as VTR as taught in col. 6, lines 61-65 of Sato et al into Fig. 2 of Sato et al since it merely amounts to selecting additional AV apparatus because Sato et al teaches additional AV apparatus can be added to the system.

Regarding claim 6, Sato et al also teaches the claimed wherein the personal video recorder comprises an internal rotating storage drive (video disk disclosed in col. 7, lines 19-26).

Regarding claim 8, Sato et al discloses the claimed wherein the video data management system automatically recognizes connection of the external rotating

Art Unit: 2615

storage drive to the video recording system (detecting the connection with the VTR 22 disclosed in col. 5, lines 39-47 and col. 7, lines 19-26).

Regarding claim 9, Sato et al also discloses the claimed wherein the external rotating storage drive is an external hard disk drive (video disk disclosed in col. 7, lines 19-26).

Regarding claim 10, Sato et al discloses the claimed wherein the isochronous interface is compatible with the IEEE 1394 standard (col. 6, lines 57-60).

Regarding claim 11, Sato et al discloses the claimed wherein the external video data stream and streaming video data include video data and audio data (col. 2, lines 56-65).

Method claim 15 is rejected for the same reasons as discussed in the corresponding apparatus claim 1 above.

3. Claims 2-3, 12-13, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Hendricks et al (US 5,990,927).

Regarding claim 2, Sato et al discloses all the claimed limitations as discussed in claim 1 above except for providing a set-top box that receives the external video data stream from a multiple-service operator.

Hendricks et al teaches a set top box (col. 3, lines 26-35) having user friendly interface for subscribers to access television programs (col. 2, lines 48-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the set top box as taught by Hendricks et al into Sato et al's

system in order to facilitate the capability of access to hundreds of television programming options.

Regarding claim 3, Hendricks et al also teaches that the set-top box comprises an internal rotating storage drive (col. 15, lines 23-33).

Regarding claim 12, Hendricks et al teaches the claimed wherein the video data management system further comprises a video data encoder that encodes at least a portion of the streaming video data (col. 10, lines 26-29).

Regarding claim 13, Hendricks et al further teaches a video data encrypter (col. 9, lines 29-30) that encrypts video data to prevent unauthorized user accessing the video signal.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the video data encrypter as taught in Hendricks et al into Sato et al's system in order to prevent unauthorized user accessing the video signal.

Method claim 16 is rejected for the same reasons as discussed in the corresponding apparatus claim 12 above.

Method claim 17 is rejected for the same reasons as discussed in the corresponding apparatus claim 13 above.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Carroll et al (US 6,016,507).

Sato et al discloses all the claimed limitations as discussed in claim 6 above except for providing wherein the internal rotating storage drive is an internal hard disk drive comprising an IDE interface.

Carroll et al teaches a well known IDE hard disk 82 (col. 4, lines 23-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IDE hard disk as taught by Carroll et al into Sato et al's system in order to increase storage capacity,

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Hendricks et al (US 5,990,927) as applied to claim 3 above, and further in view of Carroll et al (US 6,016,507).

The combination of Sato et al and Hendricks et al discloses all the claimed limitations as discussed in claim 3 above except for providing wherein the internal rotating storage drive is an internal hard disk drive comprising an IDE interface.

Carroll et al teaches a well known IDE hard disk 82 (col. 4, lines 23-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IDE hard disk as taught by Carroll et al into Sato et al's system in order to increase storage capacity.

6. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Sugiyama et al (US 5,815,631).

Regarding claim 14, Sato et al discloses all the claimed limitations as discussed in claim 1 above except for providing that the video data management system comprises an internal rotating storage drive and routes at least a portion of the streaming video data to the internal rotating storage drive.

Sugiyama et al teaches in the AV system, one AV device may be designated as an AV center and one or more AV devices may be coupled thereto and, as such, designated as a child (salve) AV device or devices (col. 4, lines 53-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of selecting any AV device as AV center as taught in Sugiyama et al into Sato et al's system in order to increase the flexibility of the system of Sato et al. When the disk player is selected as AV center, the disk became internal rotating storage drive.

Method claim 18 is rejected for the same reasons as discussed in apparatus claim 14 above.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Sugiyama et al (US 5,815,631) as applied to claim 18 above, and further in view of Wieland (DE 3106125 A1).

The combination of Sato et al and Sugiyama et al discloses all the claimed limitations as discussed in claim 18 above except for providing routing the portion of the streaming video data to the external rotating storage drive when the storage capacity of the internal rotating storage drive is insufficient to accommodate the anticipated size of the portion of the streaming video data to be recorded.

Wieland teaches that several video tape recorders are connected in parallel to the same t.v. receiver and switched on sequentially as their tapes run out (the abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of sequentially changing recording media when

Art Unit: 2615

recording space run out as taught by Wieland into Sato et al's system in order to complete record the video program even when recording space run out.

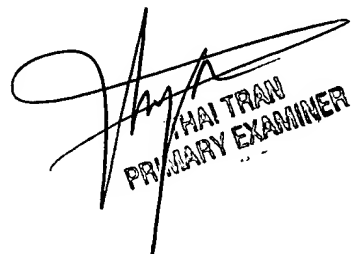
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ


THAI TRAN
PRIMARY EXAMINER